

**REMARKS**

In the Office Action mailed on September 23, 2005, the Examiner rejected claims 19 and 22 under 35 U.S.C. § 112 as being indefinite and rejected claims 1, 2, 13-23, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by *Jagid et al.*, International Patent Application Publication No. WO 00/70530 ("*Jagid*"). Under 35 U.S.C. § 103(a), the Examiner rejected claims 3-4 as being obvious over *Jagid*; claims 5-6 as being obvious over *Jagid* in view of *Brown et al.*, U.S. Patent Application Publication No. 2002/0118111 A1 ("*Brown*"); and claims 8-12, 31, and 32 as being obvious over *Brown*. Finally, the Examiner rejected claims 24 and 25 under 35 U.S.C. § 103(a) as being obvious over *Brown* in view of *Muhme*, U.S. Patent No. 5,886,634 ("*Muhme*").

By this paper, Applicant has amended claims 1, 2, 7, 8-10, 13, 14, 16, 19, 20, 22, and 29-31 to clarify aspects of the invention. Applicant has also cancelled claims 3-4 and 23-25, without prejudice or disclaimer of any subject matter. Accordingly, claims 1, 2, 5-22, and 29-32 are pending.

*Section 112 Rejections*

In the Office Action, the Examiner rejected claims 19 and 22 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out the subject matter of the invention. By this Amendment, Applicant has amended claims 19 and 22 to clarify the claimed subject matter. Therefore, Applicant requests the withdrawal of the section 112 rejections.

*Section 102 Rejections*

The Examiner also rejected claims 1, 2, 13-23, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by *Jagid*. To anticipate a claim, the reference must teach

every element of the claim. M.P.E.P. § 2131.01 (8<sup>th</sup> ed. 2001, revised August 2005).

As amended, claims 1, 2, 13-23, 29, and 30 recite elements not disclosed in the reference. Accordingly, Applicant requests the reconsideration and withdrawal of the section 102 rejections of these claims.

For example, amended claim 1 recites a method of managing rental equipment including the steps of storing a rental list of a plurality of rental equipment items removed by a customer from one of a plurality of second secure areas connected to a first secure area, the one second secure area being assigned to the customer; automatically generating a return list of rental equipment items returned to the second secure area by the customer; and determining at least one missing rental equipment item listed on the rental list and not listed on the return list. *Jagid* does not teach at least these elements of claim 1.

First, *Jagid* does not disclose storing a rental list of a plurality of rental equipment items removed by a customer from one of a plurality of second secure areas connected to a first secure area, the one second secure area being assigned to the customer. Instead, *Jagid* discloses an automated rental car system with vehicle-mounted sensors that communicate with a rental terminal at a rental lot when a customer rents and returns a car. (*Jagid*, Abstract; p. 8, l. 8 - p. 9, l. 6.) In the Office Action, the Examiner alleged that the rental lot is a first secure area and that parking spaces within the rental lot are second secure areas. (9/23/05 Office Action, p. 3.) However, there is no teaching in the reference that any part of the rental lot, including its parking spaces, is "secure" or "assigned to the customer," as the second secure area of claim 1 is.

Second, the reference does not teach storing a rental list of a plurality of rental equipment items removed by the customer, automatically generating a return list of rental equipment items returned by the customer, or determining at least one missing rental equipment item. In the Office Action, the Examiner alleged that it would have been obvious in the system of *Jagid* to compare the type of car returned to the type of car rented so that a customer could not rent a luxury car but return an economical small car. (9/23/05 Office Action, p. 6). Even if this is true, comparing one type of car to another does not provide a teaching of the combination of steps of storing a rental list of a plurality of rental equipment items removed by the customer, automatically generating a return list of rental equipment items returned by the customer, and determining at least one missing rental equipment item listed on the rental list and not listed on the return list.

Furthermore, claim 1, as amended, recites the step of storing a designation of the at least one missing rental equipment item together with an identifier of the customer. Because *Jagid* does not teach automatically generating a return list of rental equipment items returned by the customer and determining at least one missing rental equipment item listed on the rental list and not listed on the return list, it cannot teach storing a designation of the missing rental equipment item.

Because *Jagid* fails to disclose every element of amended claim 1, Applicant requests the reconsideration and withdrawal of the section 102 rejection of claim 1.

Claims 2, 5, and 7 depend from claim 1 and therefore indirectly incorporate its recitations. Because *Jagid* does not disclose every element of claim 1, the reference also does not disclose every element of the claims that depend therefrom. Accordingly,

Applicant requests the reconsideration and withdrawal of the section 102 rejections of claims 2, 5, and 7.

Claim 13, as amended, recites a method of managing rental equipment including the steps of storing a rental list of a plurality of rental equipment items removed from one of a plurality of secure areas, the one secure area being assigned to a customer; automatically generating a return list of equipment returned to the one secure area by the customer; and determining at least one missing rental equipment item listed on the rental list and not listed on the return list. As set forth above with respect to claim 1, *Jagid* does not teach these claim elements. Therefore, Applicant requests the reconsideration and withdrawal of the section 102 rejection of claim 13.

Claims 14 and 15 depend from claim 13 and therefore indirectly incorporate its recitations. Because *Jagid* does not disclose every element of claim 13, the reference also does not disclose every element of the claims that depend therefrom. Accordingly, Applicant requests the reconsideration and withdrawal of the section 102 rejections of claims 14 and 15.

Amended claim 16 recites a system for managing rental equipment including a rental component that generates a rental list of a plurality of rental equipment items removed from a second secure area assigned to the customer and a return component that generates a return list of rental equipment items returned to the second secure area by the customer and determines at least one missing rental equipment item listed on the rental list and not listed on the return list. For reasons similar to those set forth above with respect to claim 1, *Jagid* does not teach such a structure. Therefore, Applicant requests the reconsideration and withdrawal of the section 102 rejection of claim 16.

Claims 17-22 depend from claim 16 and therefore indirectly incorporate its recitations. Because *Jagid* does not disclose every element of claim 16, the reference also does not disclose every element of the claims that depend therefrom. Accordingly, Applicant requests the reconsideration and withdrawal of the section 102 rejections of claims 17-22.

Amended claim 29 recites a system for providing goods to a customer including a partial return component that detects a missing piece of rental equipment previously rented by a customer but not among the rental equipment returned by the customer to a second secure area and an invoice component that automatically bills the customer for costs associated with the missing piece of rental equipment. *Jagid* does not disclose such a system. Instead, *Jagid* describes a system for renting and returning a vehicle. (*Jagid*, Abstract.) In the system of *Jagid*, the return process begins when the vehicle is returned to a rental lot, i.e., "when it comes within transmission range from the outside of the rental lot." (*Jagid*, p. 9, ll. 1-4.) In this system, there is no teaching of (and there would be no need for) a partial return component that detects a missing piece of rental equipment not among the rental equipment returned by a customer to a second secure area. Because the reference does not teach every element of claim 29, Applicant requests the reconsideration and withdrawal of the section 102 rejection of claim 29.

Claim 30 depends from claim 29 and therefore indirectly incorporate its recitations. Because *Jagid* does not disclose every element of claim 29, the reference also does not disclose every element of claim 30, and Applicant requests the reconsideration and withdrawal of the section 102 rejections of claim 30.

*Section 103 Rejections*

Under 35 U.S.C. § 103(a), the Examiner rejected claims 3-4 as being obvious over *Jagid*; claims 5-6 as being obvious over *Jagid* in view of *Brown et al.*, U.S. Patent Application Publication No. 2002/0118111 A1 ("*Brown*"); and claims 8-12, 31, and 32 as being obvious over *Brown*. Finally, the Examiner rejected claims 24 and 25 under 35 U.S.C. § 103(a) as being obvious over *Brown* in view of *Muhme*, U.S. Patent No. 5,886,634 ("*Muhme*"). To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the reference or references must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001, Revised August 2005). This requirement must "be found in the prior art, and not be based on applicant's disclosure." *Id.* at § 2143.

Claims 3-4 and 24-25 have been cancelled, rendering the rejections of those claims moot.

Claims 5 and 6 depend from amended claim 1 and therefore indirectly recite a method of managing rental equipment including the steps of storing a rental list of a plurality of rental equipment items removed by a customer from one of a plurality of second secure areas connected to a first secure area, the one second secure area being assigned to the customer; automatically generating a return list of rental equipment items returned to the second secure area by the customer; and determining at least one missing rental equipment item listed on the rental list and not listed on the return list. Taken alone or in combination, *Jagid* and *Brown* do not teach at least these elements of claims 5 and 6.

In the Office Action, the Examiner alleged that it would have been obvious in the system of *Jagid* to compare the type of car returned to the type of car rented so that a customer could not rent a luxury car but return an economical small car. (9/23/05 Office Action, p. 6). Even if this is true, this would not provide a suggestion of the combination of steps of storing a rental list of a plurality of rental equipment items removed by the customer, automatically generating a return list of rental equipment items returned by the customer, and determining at least one missing rental equipment item listed on the rental list and not listed on the return list.

Furthermore, the combination of *Jagid* and *Brown* would not teach or suggest storing a rental list of a plurality of rental equipment items removed by a customer from one of a plurality of second secure areas connected to a first secure area, the one second secure area being assigned to the customer; automatically generating a return list of rental equipment items returned to the second secure area by the customer; and determining at least one missing rental equipment item listed on the rental list and not listed on the return list. *Brown* is cited merely for teaching the use of a recording device in a supply room. This would not teach or suggest storing a rental list of a plurality of rental equipment items removed by a customer from one of a plurality of second secure areas connected to a first secure area, the one second secure area being assigned to the customer; automatically generating a return list of rental equipment items returned to the second secure area by the customer; and determining at least one missing rental equipment item listed on the rental list and not listed on the return list.

Therefore, the Examiner has not shown a teaching or suggestion of every element of claims 5 and 6, and Applicant requests the reconsideration and withdrawal of the section 103 rejections of these claims.

Claims 8-12, 31, and 32 were rejected as being obvious over *Brown*. Claim 8, as amended, recites a method of managing rental equipment comprising, among other things, generating a rental list of a plurality of rental equipment items based on a reservation received from a customer, sensing an identifier of each piece of equipment as the equipment is moved into a secure area, automatically generating a return list of each piece of equipment moved into the secure area, and determining at least one missing rental equipment item listed on the rental list but not listed on the return list. *Brown* does not teach or suggest such a combination of steps.

The system of *Brown* tracks items added to or removed from a controlled inventory space. (*Brown*, Abstract.) A user in *Brown* may access information such as the presence, absence, or location of objects in inventory. (*Brown*, ¶ 0030.) When an object is moved, the user may be notified and a process may be performed, such as automatic replenishment, automatic billing or automatic return. (*Brown*, Fig. 3.) The system of *Brown* is object-focused, tracking the movements of objects and replenishing objects when they are depleted in a general-access storage space. Such as system does not disclose or suggest generating a rental list of a plurality of rental equipment items based on a reservation received from a customer and automatically generating a return list of each piece of equipment moved into a secure area assigned to the customer. Furthermore, there is no teaching or suggestion of comparing the rental list and return list to determine at least one missing rental equipment item. Thus, *Brown*



does not teach or suggest every element of amended claim 8, and Applicants request the withdrawal of the section 103 rejection of claim 8.

Claims 9-12 depend from claim 8 and are nonobvious at least because of their dependence from a nonobvious claim. Therefore, Applicant requests the withdrawal of the section 103 rejections of claims 9-12.

Amended claim 31 recites a method of managing rental equipment including the steps of providing a customer access to a secure area uniquely associated with the customer and determining a missing rental equipment item previously removed from the secure area by the customer but not among a plurality of pieces of equipment moved with a predetermined distance from the entrance of the secure area. *Brown* does not teach or suggest such a method. Instead, *Brown* discloses a system for tracking items of inventory in, for example, a storage room, video store, library, etc. (*Brown*, ¶ 0020.) The reference does not teach or suggest providing a customer access to a secure area uniquely associated with the customer, as recited in amended claim 31. Furthermore, the system of *Brown* tracks the movements of objects and replenishes objects when they are depleted in a general-access storage space. Such as system does not disclose or suggest determining a missing rental equipment item previously removed from the secure area by the customer but not among the plurality of pieces of equipment moved back into the secure area. Because the reference does not teach or suggest every element of claim 31, Applicant requests the reconsideration and withdrawal of the section 103 rejection of claim 31.

Claim 32 depends from claim 31 and is nonobvious at least because of its dependence from a nonobvious claim. Therefore, Applicant requests the withdrawal of the section 103 rejection of claims 31.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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